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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,483	09/27/2001	Robert A. Koch	BS01-080	8720
38516	7590	06/21/2005	EXAMINER	
SCOTT P. ZIMMERMAN, PLLC PO BOX 3822 CARY, NC 27519			WON, MICHAEL YOUNG	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,483

Applicant(s)

KOCH ET AL

Examiner

Michael Y. Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,12-14,16,17,19,21,22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,12-14,16,17,19,21,22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>ATTACHED</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1, 14, and 19 have been amended and claims 3, 8-9, 15, 18, 20, and 23 have been cancelled.

2. Claims 1, 2, 4-6, 12-14, 16, 17, 19, 21, 22, and 24 have been re-examined and are pending with this action.

Response to Amendment

3. Applicants' arguments with respect to claim 12 and 13 have been fully considered, but they are deemed to be moot and old rejection maintained. The rejection is respectfully maintained as set for the in the last Office Action mailed January 19, 2005. (See below)

4. Applicants' amendment and arguments with respect to claims 1, 2, 4-6, 14, 16, 17, 19, 21, 22, and 24 filed on April 19, 2005 have been fully considered, but they are deemed to be moot in view of the new grounds of rejection. (See below)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Duphorne (US 6,212,265 B1).

As per claim 12, Duphorne teaches a method for delivering a notification of an email arrival to a shared broadband appliance, said method comprising: receiving a message on an application server, said message including at least an email addressee (see col.1, lines 19-21 and col.3, lines 60-63); looking up the email addressee in a database to identify at least an internet protocol address and a user name associated with the email addressee (see col.4, lines 32-47); and sending an instruction from the application server to the shared broadband appliance based on the internet protocol address (see col.4, lines 8-13), said instruction including at least the user name and directing the broadband appliance to display a notice directed to the user name (see col.4, lines 24-31 & 35-47).

As per claim 13, Duphorne further teaches wherein the message further includes a sender email address and the instruction further directing the broadband appliance to display the sender address (see col.8, lines 28-33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 14, 16, 17, 19, 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne (US 6,212,265 B1) in view of.

INDEPENDENT:

6. As per claim 1, Duphorne teaches a method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment, said method comprising: receiving a message on an application server, said message including at least an email addressee (see col.1, lines 19-21 and col.3, lines 60-63); looking up the email addressee in a database to identify at least a subscriber directory number associated with the email addressee (see col.10, line 52 to col.11, line 2); retrieving a distinctive ring tone (see col.10, lines 15-24); sending an instruction from the application server to a service control point (see col.4, lines 8-13), said instruction including at least the subscriber directory number (see col.10, lines 58-62) and a distinctive ring tone (see col.10, lines 15-24); causing an advanced intelligent network node to initiate a call to the subscriber directory number (see col.10, line 66 to col.11,

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line 2); and sending a signal to the telephone customer premises equipment (see col.2, lines 38-42 and col.11, lines 2-14) to provide the distinctive notification to the email addressee of the email arrival (see col.4, line 44 and col.10, lines 15-24).

Duphorne does not explicitly teach wherein the ring tone is selected by the email addressee from multiple ring tones associated with the directory number, to provide a distinct notification despite different email addresses associated with the directory number. Brachman teaches of a ring tone that is selectable from multiple ring tones associated with the directory number, to provide a distinct notification (see col.75, lines 9-52).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Brachman within the method of Duphorne by implementing a distinctive ring tone selectable from multiple ring tones associated with a directory number to provide a distinct notification within the method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment because such distinctive ringing allows a subscriber to be alerted by a distinctive indication for identifying a specific notification before actually answering the call and because Duphorne teaches that the email notification signal can provide additional information such as preferred email notification signal format (see col.4, line 44).

As per claim 14, Duphorne teaches a method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment, said method comprising: receiving a message on an application server, said message

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including at least an email addressee (see col.1, lines 19-21 and col.3, lines 60-63); looking up the email addressee in a database to identify at least a subscriber directory number associated with the email addressee (see col.10, line 52 to col.11, line 2); retrieving a distinctive ring tone (see col.10, lines 15-24); sending an instruction, said instruction including at least the subscriber directory number (see col.10, lines 58-62) and the distinctive ring tone (see col.10, lines 15-24), from the application server to a network node capable of initiating a telephone call (see col.4, lines 8-13); and causing the network node to initiate a call to the subscriber directory number (see col.10, line 66 to col.11, line 2).

Duphorne does not explicitly teach wherein the distinctive ring tone is selected by the email addressee from multiple ring tones associated with the subscriber directory number, to provide a distinct notification despite different email addresses associated with the subscriber directory number. Brachman teaches of a ring tone that is selectable from multiple ring tones associated with the subscriber directory number, to provide a distinct notification (see col.75, lines 9-52).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Brachman within the method of Duphorne by implementing a distinctive ring tone selectable from multiple ring tones associated with a subscriber directory number to provide a distinct notification within the method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment because such distinctive ringing allows a subscriber to be alerted by a distinctive indication for identifying a specific notification before actually

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answering the call and because Duphorne teaches that the email notification signal can provide additional information such as preferred email notification signal format (see col.4, line 44).

As per claim 19, Duphorne teaches a system for delivering a distinctive notification of an email arrival, said system comprising: a server receiving a message, the message including at least an email addressee (see col.1, lines 19-21 and col.3, lines 60-63); a database looking up the email addressee to identify a subscriber directory number and a distinctive ring tone (see col.10, lines 15-24) associated with the email addressee (see col.10, line 52 to col.11, line 2); and a network node receiving the subscriber directory number in an instruction to initiate a call to the subscriber directory number (see col.10, line 66 to col.11, line 2), wherein the call provides the distinctive notification (see col.4, line 44 and col.10, lines 15-24) of the arrival of the email (see col.2, lines 38-42 and col.11, lines 2-14).

Duphorne does not explicitly teach wherein the distinctive ring tone is selected by the email addressee from multiple ring tones associated with the subscriber directory number, to provide a distinct notification despite different email addresses associated with the subscriber directory number. Brachman teaches of a ring tone that is selectable from multiple ring tones associated with the subscriber directory number, to provide a distinct notification (see col.75, lines 9-52).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Brachman within the system of Duphorne by implementing a distinctive ring tone selectable from multiple ring tones

associated with a subscriber directory number to provide a distinct notification within the method for delivering a distinctive notification of an email arrival because such distinctive ringing allows a subscriber to be alerted by a distinctive indication for identifying a specific notification before actually answering the call and because Duphorne teaches that the email notification signal can provide additional information such as preferred email notification signal format (see col.4, line 44).

DEPENDENT:

As per claim 2, Duphorne further teaches wherein the telephone customer premises equipment comprises a telephone device (see col.7, lines 20-22).

As per claim 4, Duphorne further teaches wherein the telephone customer premises equipment comprises a caller-id display device (see Fig.1, #20 and col.3, lines 48-59).

As per claims 5, 16 and 21, Duphorne further teaches wherein sending the signal or the instruction comprises sending a text message for display on the caller-id display device (see col.3, lines 48-59).

As per claims 6, 17 and 22, Duphorne further teaches wherein the step of looking up the email addressee in a database further comprises identifying a user name associated with the email addressee (see col.4, lines 35-47).

As per claim 24, Duphorne teaches of further comprising a mail server receiving the email (see col.2, lines 21-24).

Response to Arguments

7. Applicant's arguments filed April 19, 2005 with regards to claims 12 and 13 have been fully considered but they are not persuasive. *Duphorne* clearly teaches the claimed limitation. In the cite locations provided above, column 4, lines 8-13, *Duphorne* teaches of directing the "*email notification signal*" based on the "*email addressed to the user 18*". In column 4, lines 24-31 and 35-47, *Duphorne* teaches wherein the signal is notified to the user "*for viewing by the user 18 via the email notification device 20*". It is inherent that the signal includes at least the user name since the email is "addressed to the user". Such limitation is known and employed in conventional email systems. For the reasons above claim 12 and 13 remain rejected.

8. In response to the argument regarding claims 1, 14, and 19, specifically regarding the amended limitation. Although *Duphorne* teaches, "retrieving a distinctive ring tone" (see col.10, lines 15-19), he does not explicitly teach that the ring tone is selected by the email addressee from multiple ring tones associated with the directory number, to provide a distinct notification despite different email addresses associated with the directory number. *Duphorne* does however suggest or invite alternate embodiments because he teaches of user selection of a "preferred email notification signal format" (see col.4, line 44). *Brachman* teaches of user selection of a ring tone from a multiple ring tone associated with a single directory number (see reference

locations provided above). For the reason set forth above claim 1, 14, and 19 and it's dependent claims are rejected.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

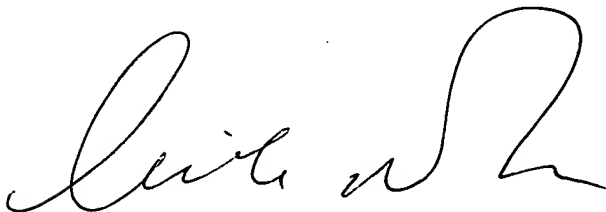
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

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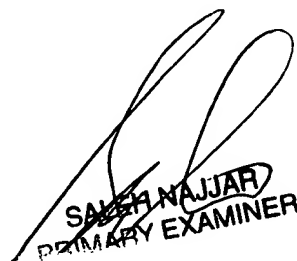
The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



June 13, 2005



SARAH NAJJAR
PRIMARY EXAMINER